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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,548	02/21/2006	Yoshimitsu Kagiwada	SHIO-0075	9811
23377 7590 10/15/2010 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER SINGH, GURKANWALJIT				
ART UNIT 3624		PAPER NUMBER		
NOTIFICATION DATE 10/15/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eoofficemonitor@woodcock.com

### Office Action Summary

**Application No.**

10/536,548

**Applicant(s)**

KAGIWADA ET AL.

**Examiner**

Gurkanwaljit Singh

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-8 and 10 is/are pending in the application.  
4a) Of the above claim(s) none is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 3-8 and 10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This final Office action is in response to applicant's communication received on June 25, 2010, wherein **claims 3-8 and 10** are currently pending. Claims 1-2 and 9 are cancelled. Claim 10 has been newly added.

#### ***Response to Amendment***

2. Applicant's amendment to the claims are insufficient to overcome the 35 USC §101 rejection set forth in the previous Office action. Applicant does not explicitly state in the system claim that it is the recited processor structure is a computer processor. More importantly, there is no indication in the claim that the recited steps are performed/executed by the computer processor. The previous 35 USC §101 rejection stands.

#### ***Response to Arguments***

3. Applicant's arguments have been considered but these arguments are geared towards newly added limitations to the amended claim 3 and the newly added claim 10. Therefore, these arguments are moot since the newly amended/added limitations are considered for the first time in the rejection below.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 3-8 and 10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method recited in **claim 10** is rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court decisions and Federal Circuit decisions. See *Bilski v. Kappos*, 561 U.S. \_\_ (2010) (Bilski). The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590.

The method recited in claim 10 is not tied to a machine nor transform the underlying subject matter to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); and *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

A method/process claim that fails to meet the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject

matter. Here claim 10 fails to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

**Claims 3-8** are drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, and, (2) produce or effect some useful, concrete, and tangible result.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski et al., (US 2002/0198791).

As per **claim 3**, Perkowski discloses a commodity control system comprising a processor; information storage means configured to store a commodity control byte data for each of a plurality of commodities, the commodity control byte data comprising a commodity identification information for identifying the commodity, manufacturer information associated with a plurality of manufacturers that have manufactured the commodity and client information associated with a plurality of clients that have acquired the commodity, communication means for communicating with an external device, and information processing means for controlling the operation of each of the means (Abstract, ¶¶ 0016-0020, 0023, 0027, 0014, 0233, 0417-0418, 0016-0020 [“collect and manage consumer product-related information and transmit the same to consumers in both physical and electronic retail shopping environments including at home, work and on the road...provide such apparatus in the form of a novel consumer-product information collection, management, transmission and delivery system...system with an Internet-based product information database subsystem which, for each

commercially available consumer-product, stores a number of information elements including: the name of the manufacturer; the Universal Product Code (UPC) assigned to the product by the manufacturer; one or more URLs specifying the location of information resources (e.g. Web-pages) on the Internet relating to the UPC-labeled consumer-product; and the like...information maintained within the Internet-based product information database management subsystem provides a manufacturer-defined consumer-product directory that can be used by various persons along the retail chain"], 0027-0031, 0035-0038, 0051, 0078, 0233 ["computer communications network"], 0417-0418), wherein the information processing means is configured to:

a) correlate commodity identification information with manufacturer information associated with one of the plurality of manufacturers to receive the correlated information from a manufacturer terminal through the communication means (¶¶ 0078 ["provide each manufacturer with a novel consumer product information catalog subsystem (RDBMS) for storing and managing media-rich consumer product information content relating to each and every UPN-indexed product that the manufacturer makes, sells and/or distributes to retailers along the retail supply and demand chain"], 0079, 0016-020, 0024, 0046-0049, 0233-0234, 0241, 0417-0418),

b) collate the received commodity identification information with the commodity identification information stored in the storage means (¶¶ 0019 ["provide such a system, in which the URLs stored in the Internet-based product information database are categorically arranged and displayed according to specific types of product information (e.g., product specifications and operation manuals; product wholesalers and retailers;

product advertisements and promotions; product endorsements; product updates and reviews; product warranty/servicing; related or complementary products; product incentives including rebates, discounts and/or coupons; etc.) that relate to the kind of information required, desired or otherwise sought by consumers, wholesalers, retailers and/or trading partners; product prices at which the products are being offered for sale by a particular retailer; and the like"], 0079 ["a novel consumer product information catalog subsystem (RDBMS) which is realizable as a standalone database application supported on one or more client machines operably connected to the LAN or WAN of the manufacturer's enterprise, and or as a network database information server connected to the LAN or WAN and being accessible to various personnel working within the manufacturer's enterprise, and using Web-enabled client machines to carry out consumer product information content management operations across the enterprise"], 0016-0020, 0024, 0417-0418),

c) specify, when the received commodity identification information has been matched with the commodity identification information stored in the storage means as a result of the collation, the commodity identified by the received identification information (¶¶ 0016-0020, 0024 ["a system with a number of different modes of operation, namely: a Manufacturer/Product Registration Mode, wherein manufacturers can register their companies and consumer products (e.g. UPC numbers and URLs) with the system; an UPN-Directed Information Access Mode, wherein consumers can access and display information menus containing UPC numbers linked to URLs pointing Web pages containing consumer product related information by scanning the UPC label on the



consumer product or by entering the UPC number thereof into a data-entry screen displayed by the system in this mode; a Manufacturer Website Search Mode, wherein the home page of a manufacturer's Web-site can be automatically accessed and displayed by scanning the UPC label on any consumer product of the manufacturer or by entering the UPC number thereof into a data-entry screen displayed by the system in this mode; a Trademark-Directed Search Mode enabling consumers to use trademarks and/or trade names associated with consumer products to search for consumer-product related information registered within the system; and a Product-Description Directed Search Mode enabling consumers to use product descriptors associated with particular consumer products to search for consumer-product related information registered within the system", 0031 ["manufacturers are enabled to simply link (i.e. relate), manage and update within a centralized database, the UPC (and/or UPC/EAN) numbers on their products and the Uniform Resource Locators (URLs) of HTTP-encoded document (i.e. Web pages) containing particular kinds of consumer product-related information published on the Internet by the manufacturers, their agents and/or third parties"], 0052-0054, 0027-0031, 0035-0038, 0051, 0078, 0417-0418),

d) extend, in a linear fashion, the commodity control byte data associated with the specified commodity by adding the received manufacturer information to the commodity control byte data associated with the specified commodity and store the commodity control byte data to the storage means (Figs. 2-1 – 2-2, 2B1-4, 2C, 2C2, 11-13, 37-43 (And the respective explanations in the specifications regarding these figures), Abstract ["stores in a central database"], ¶¶ 0019 ["stored in the internet-based

product information database"], 0020, 0029, 0031-0034, 0049-0051, 0052-0055, 0233, 0417-0418),

e) correlate the identification information for identifying the commodity with the client information associated with one of the plurality of clients to receive the correlated information from a client terminal through the communication means (¶¶ 0048-0052, 0016-0020, 0024, 0067, 0078, 0091, 0417-0418),

f) collate the received commodity identification information with the commodity identification information stored in the storage means (¶¶ 0048-0052, 0016-0020, 0024, 0067, 0078, 0091, 0417-0418),

g) specify, when the received commodity identification information has been matched with the commodity identification information stored in the storage means as a result of the collation, the commodity identified by the received identification information (¶¶ 0031 ["consumers, in retail stores, at home, in the office and on the road, are enabled to simply access such consumer product-related information using such UPC (and/or UPC/EAN) numbers and/or by scanning UPC (or UPC/EAN) bar code symbols encoded with such product identification numbers"], 0054-0059, 0016-0020, 0027-0031, 0035-0038, 0051, 0078, 0417-0418), and

h) extend, in a linear fashion, the commodity control byte data associated with the specified commodity by adding the received client information to the commodity control byte data associated with the specified commodity and store the commodity control byte data to the storage means (Figs. 2-1 – 2-2, 2B1-4, 2C, 2C2, 11-13, 37-43 (And the respective explanations in the specifications regarding these figures), Abstract

["stores in a central database"], ¶¶ 0019 ["stored in the internet-based product information database"], 0020, 0029, 0031-0034, 0049-0051, 0052-0055, 0233, 0417-0418).

Perkowski does not explicitly state correlate information and collate information. However, correlating means "to place in relation" ("Correlating." Dictionary.com Unabridged. Random House, Inc. 18 Mar. 2010) and collating means to "gather or arrange in sequence" ("collating." Dictionary.com Unabridged. Random House, Inc. 18 Mar. 2010). Perkowski does disclose placing information in relation to other information and gathering or arranging information in a certain way/sequence (Abstract, ¶¶ 0016-0020, 0023, 0027, 0014, 0233, 0417-0418).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have correlated and collated information as taught by the definitions of the terms and by Perkowski itself, with the motivation to communicate information efficiently by gathering or arranging information in a certain way and to place the information in relation to one another.

Additionally, extending data in a linear fashion has no effect on the method stated in the claim. The system/method described in the claim would operate the same regardless of whether the data was extended in a linear fashion. Applicant does not state explicitly in the claims what it means to extend the data in a linear fashion as per the claimed invention. Applicant further does not show how the data is extended in a

linear fashion and what the functionality is in regards to the claim/claimed invention. As a result, the only difference between the claimed invention and the prior art is that Applicant provides different data type, or nonfunctional descriptive identifying materials, to the same method of operating a computer system. See MPEP §2106. Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to create any data type to operate the method/system of Perkowski with the motivation of adding the received manufacturer information, wherein such data labels do not functionally affect the operations of the system.

As per **claim 4**, Perkowski discloses the system above, characterized in that the processing means receives the commodity identification information or the manufacturer information from an information searcher terminal through the communication means, reads out the client information correlated with the received identification information or manufacturer information from the storage means, and transmits the read client information to the information searcher terminal (§¶¶ 0037-0043 ["kiosk"], 0049, 0074, 0102-0107, 0133-0140, 0150-0154, 0179, 0182-0186, 0243, 0271-0272, 0280-0281, 0327-0331, 0382-0384, 0417-0418, 0016-0020, 0023, 0027, 0014, 0233).

As per **claim 5**, Perkowski discloses the system above, characterized in that the processing means receives the client information from the information searcher terminal through the communication means, reads out from the storage means the identification information or/and manufacturer information correlated with the received client information, and transmits the read identification information or/and manufacturer information to the information searcher terminal (§¶¶ 0037-0043 ["kiosk"], 0049, 0074,

0102-0107, 0133-0140, 0150-0154, 0179, 0182-0186, 0243, 0271-0272, 0280-0281, 0327-0331, 0382-0384, 0417).

As per **claim 6**, Perkowski discloses the system above, characterized in that the processing means receives the commodity identification information from the information searcher terminal through the communication means, reads out from the storage means the manufacturer information correlated with the received identification information, and transmits the read manufacturer information to the information searcher terminal ((¶¶ 0037-0043 ["kiosk"], 0049, 0074, 0102-0107, 0133-0140, 0150-0154, 0179, 0182-0186, 0243, 0271-0272, 0280-0281, 0327-0331, 0382-0384, 0417)).

As per **claim 7**, Perkowski discloses the system above, characterized in that the processing means receives the commodity manufacturer identification information from the information searcher terminal through the communication means, reads out from the storage means the identification information correlated with the received manufacturer information, and transmits the read identification information to the information searcher terminal ((¶¶ 0037-0043 ["kiosk"], 0049, 0074, 0102-0107, 0133-0140, 0150-0154, 0179, 0182-0186, 0243, 0271-0272, 0280-0281, 0327-0331, 0382-0384, 0417)).

As per **claim 8**, Perkowski discloses the system above, wherein the storage means stores the manufacturer information, including process information of manufacturing processes in the manufacturer, the processing means receives, when the received manufacturer information is added to the storage means for each of the specified commodities, the process information included in the manufacturer information from the manufacturer terminal through the communication means for each of the

manufacturing processes, and also adds the process information included in the received manufacturer information to the storage means for each of the manufacturing processes (Abstract, ¶¶ 0019, 0016-0020, 0029, 0031-0034, 0049-0051, 0052-0055, 0233, 0417-0418, 0037-0043 ["kiosk"], 0074, 0102-0107, 0133-0140, 0150-0154, 0179, 0182-0186, 0243, 0271-0272, 0280-0281, 0327-0331, 0382-0384).

**Claim 10** recites substantially similar limitations to claim 1 and is therefore rejected under the same rationale and reasoning as discussed above for claim 1.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gurkanwaljit Singh whose telephone number is

(571)270-5392. The examiner can normally be reached on Monday to Thursday 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571)272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. S./  
Examiner, Art Unit 3624  
October 8, 2010

/Romain Jeanty/  
Primary Examiner, Art Unit 3624